

### **REMARKS**

Applicant has further amended the claims as previously presented on April 2, 2009, by amending claim 127 to change the phrase “of a keypad, mouse or trackball” to read “customer input device”. The previous form of the claim was too narrow insofar as the specification clearly provides for other customer input devices other than the “keypad trackball and mouse.” See for example, column 4 lines 13-17 which includes “actuating buttons 120, 121 and 112 of selector panel 160, a keypad 118, trackball 117...”. As disclosed at column 5 lines 7-11 the “plurality of selector buttons or switches 120, 121 and 122 connected to the computer assembly 158 to enable the customer to log on to pre-programmed internet sites, such as news, financial, or video music websites and homepages”. Further, at column 5 lines 32-35 it is taught “using drives 116 and 128, the customer may also send audio and video messages to websites and homepages, capable of receiving information and to transmit data to remote receivers”. Thus, it is clear that the instant specification provides support for customer input devices other than the “keypad, mouse or trackball” which was deemed too limiting in previous version of claim 127. However, the embodiment using a keypad, mouse or trackball has been covered by new claim 141 dependent on independent claim 127, in which the customer input device is at least one of a keypad, mouse or trackball. As noted above support for such keypad, trackball or mouse can be found throughout the original specification for example, at column 4 lines 13-16, column 5 lines 12-13, 20-21 and column 6 lines 23-32. The claim also emphasizes that only after the drink has been vended is the customer permitted to be connected to a website of the customer’s choice (column 8, line 13 *et seq*, especially lines 13-20 and 32 to column 9, line 50). This difference is significant and exists because a vending machine with internet access continues to permit vending as its primary purpose whereas a kiosk with only internet access was never intended to vend anything and the dispensing of paper with information taken

from the internet can only take place after the customer's interaction with the internet. Accordingly, none of the foregoing amendments raise the issue of new matter.

Claims 1-12 are the original claims and of these claims, claims 1, 3, and 12 have been previously amended. Claims 31-41, 60-127 and 129-141 which are the new claims added to this broadened reissue application remain pending. Claims 13-30, 42-59 and 128 are cancelled.

Initially, applicants appreciate the courtesies extended by SPE DeCady, Examiner Garland and QAS Ms. Chaki during a telephonic interview conducted on September 9, 2009, with both inventors and undersigned counsel. During the aforementioned interview, the questions of the Rule 131 Declarations concerning applicant's attempt to antedate the cited Sokal reference having a filing date of October 10, 1995, were discussed at length.

Ms. Chaki suggested that it would be helpful to have a "roadmap" to satisfy applicants legal burden of proving conception of the invention at a date prior to the October 10, 1995, filing date of the Sokal reference, coupled with reasonable diligence from just prior to October 10, 1995, to an actual or constructive reduction to practice.

Although applicants submit that the voluminous record including a number of various Declarations, provides evidence of record suitable to conclude that applicants have already satisfied their burden, both as to date of conception as well as to the reasonable diligence, applicants are willing to accommodate the Office and attaches a "road map" or a brief abstracting of the Declaration of record on a day-by-day basis, even though applicants has previously argued and the Board has agreed, there is no legal duty to identify activity on a day-to-day basis. However, the "road map" is not intended as a substitute for the evidence of record, but is merely an aid to assist the Office in analyzing the evidence of record. It will be seen that even the "road map" is voluminous and it was too cumbersome to include all the activities of the co-inventor Dr. Johnson Asamadu in the "road map" abstracting. Therefore, Dr. Asamadu's Supplemental Declaration submitted herewith has been drafted to

be independently considered a “road map” of his activities in the time period of March 22 to September 18, 1996. Therefore, it should be read in conjunction with the “road map” provided

Examiner Garland issued at least 4 Office Actions on the merits (including the non-final Office Actions of December 17, 2001; March 27, 2002, August 26, 2002; and the Final Rejection of January 28, 2003) before he ever cited the Sokal reference now at issue. Therefore, some of applicant’s earliest Declarations dealt with other references which are no longer at issue.

However, in preparing the attached “roadmap” requested by QAS Chaki, it can be seen that applicants not only have carried their burden of satisfying evidence of conception prior to the Sokal reference but also reasonable diligence from just prior to the October 10, 1995, filing date of Sokal to the constructive reduction to practice.

In addition, applicants wish to note that the application properly names joint inventors, although not each inventor was the inventor of each claim in this application. For a breakdown of the claims and their respective inventorship applicants direct the Examiner’s attention to the rule 132 Declaration of Mr. James A. Satchell Jr., and Mr. Johnson Asumadu in response to request for information which was executed by each of the inventors on March 26, 2005, and filed March 31, 2005, in the United States Patent and Trademark Office.

Before discussing the “roadmap” requested by Ms. Chaki, applicants also wish to note that they filed herewith two additional Supplemental Declarations of the inventors directed to the questions as asked by Ms. Chaki during the aforementioned telephonic interview conducted on September 9, 2009.

In the Satchell Declaration, Mr. Satchell addresses the issue relating to facsimile filing of a paper on November 8, 1995, as well as a “hardcopy” of the same paper filed (with a mailroom date stamp) of December 26, 1995. Mr. Satchell also addresses the issue of working “at” the home office and the fact that he was “building” (constructing) and

“creating” this home office as part of the invention as it progressed from a “unimproved lot” towards a site at which a network of vending machines could be operated therefrom.

Also filed herewith is a Supplemental Declaration of Dr. Asumadu, who is now a professor at the University of Michigan, but who was, at the time of the invention, a professor at Tuskegee University and in fact was in the process of changing positions from Tuskegee University to the University of Michigan during the summer of 1995 (i.e. during the diligence period). Therefore, some of the context of the “moving” statements of Dr. Asumadu during the diligence period was due to this change in location of employment.

Turning now to the evidence of conception, prior to October 10, 1995, Applicants direct attention to the “Supplemental Declaration of Doris Stroud, executed by Ms. Stroud on January 22, 2004, which and filed in the United States Patent and Trademark Office on February 23, 2004, states unequivocally in paragraph 12 that “I specifically recall that the following information was conveyed to me by Mr. Satchell at least as early as August 17, 1995 [prior to the effective filing date of Sokal of October 10, 1995]

a. the claim of his application, reciting a vending machine including a device to access the internet or worldwide web, incorporated, for example in the door of the machine. The machine could also provide entertainment or advertisements, such as live news, pre-recorded music or videos and live auditions for television commercials. The purchase of, for example, a soda could be used to activate the device, which could also include a video screen, stereo speaker, a satellite receiver antenna, cameras, a video recorder-playback machine, cassette dispenser, motion detectors, multi-selection panels, and adaptors in the door to permit internet or worldwide web access”.

Ms. Stroud was a former employee of the United States Patent and Trademark Office from 1970 until her retirement in 2000, and recalls that Mr. Satchell was applying for his patent application [U.S. Serial number 429,583 filed August 17, 1995] pro se and it was part

of her duties to assist pro se applicants in filing their patent applications; See paragraphs 2 and 4 of the Stroud Declaration.

Ms. Stroud “specifically recalls discussions with Mr. Satchell concerning his invention for providing patrons or customers of vending machines with internet/worldwide web access, by including in said vending machine a public access to the internet/worldwide web with a vending machine door which included a video screen and selector mechanism to access websites and other internet/worldwide web information” because she “made notes of them” in her efforts to assist the pro se applicant Mr. Satchell; See paragraph 7 and 8 of the Stroud Declaration.

Thus, there is clearly a corroborated statement of conception of the invention conveyed by James A. Satchell Jr. by an independent third party with no financial interest in this invention (Paragraph 13 of the Stroud Declaration).

In addition, in the Declaration of James A. Satchell Jr. under 37 CFR 1.131 executed August 10, 2004 [and resubmitted August 20, 2004] Mr. Satchell attaches, as exhibit A to his Declaration a disclosure of his invention, including a “laser-disc music video digital drink machine door” with internet access including various designs that combine the purchase of soda products with informational, entertainment, customer auditioning post. Designs included replacement door for existing [vending machines] 2. mounted walls units for eating areas (interior uses) 3. as a drive-through wall unit mounted on the exterior of an existing building with the soda cooler, brain components, money box etc safely stored inside a building and a soda-island i.e., a building designed for parking-lots, which permits customers to remain in their car while purchasing a soda with the laser-disc music video digital drink machine doors on both sides entertain/serve customers while storage for video/audio components, money etc are safely stored inside the building”. This disclosure was also witnessed by two non-inventors, Mrs. Patricia Satchell (James A. Satchell Jr.’s wife) and Kiwanis L. Satchell (Mr. Satchell’s mother). This disclosure is dated September 18, 1995,

immediately predating the cited Sokal reference having a date of October 10, 1995. Thus, the Declaration of Ms. Stroud corroborating numerous details of the invention coupled with the exhibit A to the Declaration of Mr. Satchell, also independently witnessed, demonstrate conception of the invention prior to the date of Sokal and further the exhibit A, containing additional embodiments of the invention in addition to the “replacement door for existing vending machines” further demonstrates the continued diligence in attempting to reduce the invention to practice (either actual or constructive).

Although a day by day showing of diligence is not required (as confirmed in the Board’s decision of November 2008, in this application) applicants, through numerous Declarations have provided such a day by day showing of diligence. This diligence, although present in various Declarations throughout this record, are abstracted in the attached “roadmap” showing daily dates from October 10, 1995, to September 18, 1996, the date of filing the application Serial Number 715,232 on September 18, 1996, which matured into the patent being reissued. Applicants respectfully submit that this “roadmap” is only an assistant to the Examiners in understanding the showings already made of record in various Declarations of not only the inventors but also other third party witnesses.

Lastly, applicants provide herewith the reported authority of *In re Ackermann*, 170 USPQ 340 (CCPA 1971) citing *In re Herr*, 153 USPQ 548, 549(CCPA 1967) [both cases following examination after previous Board decision found] that

the patent Office, in discharging its duties to the public...should be equally alert in protecting the rights of applicants who have legally and properly established such a right; to do otherwise would be to unjustly enrich the public at expense of inventor, a result Congress could not have intended.

Therefore, notwithstanding the previous Board decision upon further amendment and/or Declaration evidence a previous decision of a tribunal (such as the Board of Appeals) has no effect, because the claims now presented for examination were not the claims considered by the Board. Thus, the Examiner must begin anew his entire analysis of

obviousness under 35 U.S.C. 103 (a) and cannot rely on the Board's decision for any validation of that analysis.

Applicants submit that a claim, such as independent claim 127, which requires a customer to be automatically connected to at least one predetermined website upon activation of the money acceptor or credit card reader... causing a drink to be vended, "and thereafter permitting the customer access to at least one website of the customer's choice" cannot possibly be taught by any of the combination of references cited by the Board. This is especially true if the Board's view that the "vended item" of Sokal is the "paper" upon which information is printed because the black paper is never "vended" especially when the customer captures the data on his own memory device. Furthermore, in Sokal connection to the internet must always precede the dispensing of the paper, while in claim 127 the drink is vended before connection to the Internet.

In view of the foregoing a prompt and favorable reconsideration including withdrawal of all the rejections and passage of the application to issue are respectfully requested.

The Director is hereby authorized to charge any deficiency in the fees filed, asserted to be filed or which should have been filed herewith (or with any paper hereafter filed in this application by this firm) to our Deposit Account No. 14-1437, under Order No. 8685.002.US0001.

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Respectfully submitted,



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